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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,070	08/10/2001	Reinhold Schopf	DT-4067	7331

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\*EXAMINER

GUADALUPE, YARITZA

ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/928,070

Applicant(s)

SCHOPF, REINHOLD

Examiner

Yaritza Guadalupe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 8-10 and 13-15 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Newly submitted claims 11 - 12 and 16 - 17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the break off region in the stem as claimed can be made by another and materially different process such as one that does not require heat-treating a region of the stem.
2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11 - 12 and 16 - 17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8 - 10 are rejected under 35 U.S.C. 102 ( b ) as being anticipated by Kendall ( US 4,826,372 ).

Kendall discloses a stem ( 14 ) and a break - off region / breakneck region ( 24 ) provided in the stem consisting of a changed structure of a stem material formed along the circumference of the stem ( See Figure 1 ) and wherein the diameter of the stem ( 14 ) at the break – off point ( 24 ), is considered substantially unchanged ( See Figures ), since the area of deflection is so small that will not give a considerable change in the diameter of the stem . Kendall discloses said stem being metallic ( See Column 13, lines 27 – 29 ).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Possati et al. ( US 5,299,360 ) in view of Kendall ( US 4,826,372 ).

Possati et al. discloses a device having a stylus / touch probe comprising a stem ( 12 ), and a break-off region ( 14 ) provided in the stem consisting of a changed structure of a stem material. Possati et al. discloses the break – off region formed along the circumference of the stem ( See Figure 1 ). Possati et al. discloses the diameter of the stem ( 12 ) at the break – off

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point, in a broad sense, considered to remain substantially unchanged, since the area of deflection is so small that will not give a considerable change in the diameter of the stem .

Possati does not disclose the diameter of the stem in the brake off region remaining substantially unchanged as stated in claim 13. Possati et al. does not disclose the stem made of a hard metal as stated in claim 15.

Regarding claims 13 and 15 : Kendall discloses a stem ( 14 ) and teaches the use of a break - off region / breakneck region ( 24 ) provided in the stem consisting of a changed structure of a stem material formed along the circumference of the stem ( See Figure 1 ) and wherein the diameter of the stem ( 14 ) at the break – off point ( 24 ), is considered substantially unchanged (See Figures), and the diameter desirable to be maximized so as to maximized the load carried by the stem ( See Column 10, lines 20 – 23 ). Kendall further discloses said stem being metallic (See Column 13, lines 27 – 29). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the break off region disclosed by Possati et al. with a break off region / breakneck region and metallic stem as taught by Kendall in order to increase the capabilities of the stem by allowing maximum deformation / flexibility that allows for maximum range of motion while measuring and minimizes the range for total breakage of the stem while in use.

*Response to Arguments*

7. Applicant's arguments with respect to claims 13 - 17 have been considered but are moot in view of the new ground(s) of rejection.

Applicant arguments on the break off region being substantially unchanged : Applicant arguments are not persuasive because the claimed language employed failed to clearly differentiate the claimed subject matter from the Prior Art applied. Applicant relies in a stem having a break off region which diameter remains substantially unchanged, however, the term “substantially” does not clearly defines the metes and bounds of the claimed subject due to being a relative term. In a broad sense, Possati et al. discloses a “substantially” unchanged diameter at the break off region.

*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676. The examiner can normally be reached on 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-4467 for regular communications and (703)872-9318 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



Yaritza Guadalupe  
Patent Examiner  
Art Unit 2859  
May 12, 2003

DIEGO F.F. GUTIERREZ  
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